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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/391,335

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 601-660 and 709-761 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 544, 546-551, 553-560, 562-572, 582-591, 594-600, 661-708, 762-786, 790-791, 794-808 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 544,546-551,553-560,562-572,582-591,594-601,603-608,610-617,619-630,632-643,645-648,651-723,725-786,790,791 and 794-808.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/06 has been entered.

Response to Amendment

2. In the amendment filed 11/27/06, the following has occurred: claims 575, 578, 579, 581, 592, 593, 609, 631, 787, 788, 789, 792, and 793 have been canceled, claims 796-808 have been added, and claims 544, 546, 558, 564, 585, 598, 600, 601, 603, 615, 621, 630, 632-636, 655, 657-661, 663, 680, 681, 694, 705, 707, 709, 710, 712, 718, 729, 730, 754, 759, 761, 762, 776, 782-784, 790, and 795 have been amended.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 661-665, 667-677, 679, 681-685, 687-693, 695-704 and 706-708 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino, U.S. Patent No. 4,648,037 in view of Foster, Portability of pension benefits among jobs (hereinafter Foster, paragraphs numbered by Examiner).

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5. As per claim 661, Valentino teaches a computer implemented method, comprising: receiving a request for information regarding an employee benefit in an employee benefits account, wherein the employee benefits account includes at least one of healthcare insurance, disability insurance and life insurance and at least one of a retirement benefit account and a pension benefit account (see column 7, lines 22-34); processing the request for information regarding an employee benefit with a processing device using employee benefits information stored in a database or memory device (see column 7, lines 43-58), wherein the employee benefits information comprises information regarding an employee benefit associated with an employee, wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current employment relationship wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer (see column 2, lines 28-32,); generating a message in response to the request for information regarding an employee benefit, wherein the message contains a response to the request for information regarding an employee benefit (see column 7, line 59 – column 8, line 3); and transmitting the message to a communication device associated with at least the employee (see column 7, line 59 – column 8, line 3).

6. While the employee benefits in Valentino are established in an employment relationship and then maintained overtime in a current employment relationship, Valentino fails to explicitly teach that the employee benefit exists from a previous employment relationship with a first employer and maintained by the employee in a current employment relationship with a second employer as recited. However, Foster discloses transferring employ benefits from a first employer in a previous employment relationship to a second employer in a current employment relationship, wherein the employee benefit from the previous employment relationship with the

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first employer is paid for or provided at least in part by the second employer in or pursuant to the current employment relationship with the second employer and is included in employee benefits provided to the employee by the second employer (see paragraphs 7-10 and 17-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Valentino. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing flexibility to the employee in the management of existing benefits (see column 2, lines 21-27 of Valentino).

7. As per claim 662, Valentino teaches the method of claim 661 as described above.

Valentino further teaches receiving and processing a request or claim for an employee benefit (see column 14, lines 34-36); and generating and transmitting a second message in response to the request or claim for an employee benefit (see column 14, lines 36-44).

8. As per claim 663, Valentino teaches the method of claim 662 as described above.

Valentino further teaches the method of claim 662 as described above. Valentino further teaches the second message contains information regarding a providing of an employee benefit requested or claimed in the request or claim for an employee benefit (see column 14, lines 36-44).

9. As per claim 664, Valentino teaches the method of claim 662 as described above.

Valentino further teaches providing the employee benefit requested or claimed in the request or claim for an employee benefit (See column 14, lines 40-44, the Examiner interprets the generation of a check in response to a benefit transaction to be a provision of the employee benefit).

10. As per claim 665, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information regarding a registration or subscription for an employee benefit (see column 9, lines 46-51).

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11. As per claim 667, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information regarding a purchase of an enhanced employee benefit or an upgraded employee benefit (see column 9, lines 41-54).

12. As per claim 668, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information regarding a purchase of an employee benefit (see column 9, lines 41-54).

13. As per claim 668, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information regarding a change to an employee benefit (see column 9, lines 41-54).

14. As per claims 670-673, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the employee benefit associated with an employee include those recited (see column 2, lines 1-20).

15. As per claim 674, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the message contains information regarding at least one of the listed items (see column 2, lines 1-20).

16. As per claim 675 Valentino teaches the method of claim 661 as described above.

Valentino further teaches the employee benefits information comprises at least one of the listed items of information (see column 2, lines 1-20).

17. As per claim 676 Valentino teaches the method of claim 661 as described above.

Valentino further teaches the communication device is at least one of the recited devices (see column 4, lines 46-60).

18. As per claim 677, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the communication device is a TV or an interactive TV (see column 4, lines 46-60).

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19. As per claim 679, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the communication device is a kiosk (see column 4, lines 41-45).

20. As per claim 681, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the method is utilized on or over an intranet (see column 3, line 64 – column 4, line 4, the Examiner interprets the company-wide network of Valentino to be a form of intranet).

21. As per claim 682, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the processing device is at least a network computer (see column 3, line 64 – column 4).

22. As per claim 683, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the employee benefits information is automatically updated in real-time (see column 2, lines 34-39).

23. As per claim 684, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the employee is an independent contractor (see column 2, lines 39-43).

24. As per claim 685, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information regarding a purchase pursuant to an employee discount benefit or buying service benefit (see column 15, lines 14-17).

25. As per claim 687, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information regarding at least one of the listed items (see column 9, lines 46-51).

26. As per claim 688, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information regarding a registration with a service provider (see column 9, line 51).

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27. As per claim 689, Valentino teaches the method of claim 661 as described above.

Valentino further teaches providing information to an employer regarding a transaction between the employee and at least one of a healthcare, disability, and insurance provider (see column 5, lines 55-59).

28. As per claim 690, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the processing device is linked to at least an employer computer (see column 5, lines 55-59).

29. As per claim 691, Valentino teaches the method of claim 661 as described above.

Valentino further teaches storing information regarding at least one of a benefit, benefit package, and a benefit pricing (see column 5, lines 16-22) and information regarding a requirement or a need for a benefit associated with an employer or employee (see column 2, lines 22-27); processing the information regarding at least one of a benefit, benefit package, and a benefit pricing with information regarding a requirement or a need for a benefit (see column 2, lines 22-27); identifying a benefit provider for providing at least one of a benefit and benefit information for the requirement for a benefit or for the need for a benefit (see column 2, lines 28-32); generating and transmitting a second message containing information regarding the benefit provider (see column 2, lines 28-32).

30. As per claim 692, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the message contains a link to a computer associated with the processing device (see column 3, lines 31-34).

31. As per claim 693, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the employee benefits information further comprises information regarding an individual benefits account that exists independently of an employment relationship (see column 7, lines 8-9).

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32. As per claim 695, Valentino teaches the method of claim 661 as described above.

Valentino further teaches providing information to a benefit provider regarding and employee who has upgraded a benefit (see column 5, lines 55-59).

33. As per claim 696, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information for allowing an employee to utilize monies or credits or funds (see column 14, lines 40-44, it is noted that the intended use of money provided to employees does not distinguish the claim from the prior art).

34. As per claim 697, Valentino teaches the method of claim 661 as described above.

Valentino further teaches processing information for allowing an employee to create an individual benefits account that exists independently of an employment relationship (see column 7, lines 6-9); and wherein the employee pays for or in part with at least one of funds, monies, and credits, provided by an employer (see column 14, lines 40-44, it is noted that the intended use of money provided to employees does not distinguish the claim from the prior art).

35. As per claim 698, Valentino teaches the method of claim 661 as described above.

Valentino further teaches utilizing at least a software agent to perform at least one of the recited functions (see column 4, lines 41-45).

36. As per claim 699, Valentino teaches the method of claim 661 as described above.

Valentino further teaches transmitting at least one of a benefit request form, a benefit information request form, a claim submission form, and a claim status form, to the communication device (see column 5, lines 39-48).

37. As per claim 700, Valentino teaches the method of claim 661 as described above.

Valentino further teaches transmitting information regarding at least one of the listed items (see column 7, lines 5-18).

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38. As per claim 701, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the message is contained in at least an electronic transmission (see column 3, lines 31-42).

39. As per claim 702, Valentino teaches the method of claim 661 as described above.

Valentino further teaches utilizing at least an electronic authorization to file a financial transaction form (see column 7, lines 35-46).

40. As per claim 703, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the message is transmitted to the communication device in real-time (see column 2, lines 34-39).

41. As per claim 704, Valentino teaches the method of claim 661 as described above.

Valentino further teaches effectuating a payment pursuant to an employee benefit in response to a request for an employee benefit or a claim for an employee benefit (see column 14, lines 40-44).

42. As per claim 706, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the request for information regarding an employee benefit is transmitted from the communication device (see 13, lines 26-31).

43. As per claim 707, Valentino teaches the method of claim 661 as described above.

Valentino further teaches the employee benefits information comprises information regarding an individual benefits account, wherein the individual benefits account is utilized by the employee to retain a benefit with a benefit provider independently of an employment relationship (see column 2, lines 28-43).

44. As per claim 708, Valentino teaches the method of claim 707 as described above.

Valentino further teaches. The individual benefits account includes at least one of those listed benefits (see column 2, lines 1-20).

45. Claims 762-765, 768-777, and 768-781 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino, U.S. Patent No. 4,648,037 in view of Secrist, Intelligent messaging system notifies plant personnel (paragraphs numbered by Examiner, hereinafter Secrist) and further in view of Fox et al., U.S. Patent No. 6,654,786.

46. As per claim 762, Valentino teaches a computer implemented method comprising: storing employee benefits information in a database or a memory device (see column 3, lines 57-61); detecting at least one of an offering of a benefit and a posting of an offer to sell a benefit or a benefit package, wherein the at least one of an offering of a benefit and a posting of an offer to sell a benefit or a benefit package, is automatically detected by a processing device (see column 2, lines 1-10, in particular, benefit news bulletins); generating a message containing information regarding the at least one of an offering of a benefit and a posting of an offer to sell a benefit or a benefit package, wherein the message is automatically generated by the processing device upon the detection of the at least one of an offering of a benefit and a posting of an offer to sell a benefit or a benefit package (see column 4, lines 5-23, the Examiner interprets the generation of information regarding available benefits to be form of the claimed generation); and transmitting the message to a communication device associated with an employee or a benefit beneficiary (see column 4, lines 5-23).

47. Valentino does not explicitly teach the detected offering or posting is of a benefit or benefit package not available to an employee or a benefit beneficiary in or pursuant to an employment relationship prior to the at least one of an offering of a benefit and a posting of an offer to sell a benefit or a benefit package. However, Secrist teaches a software application that monitors events in a business environment and automatically broadcasts messages based on changes in the business environment (see paragraphs 6-8). Furthermore, Secrist teaches that

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the software application can be utilized to broadcast messages to employees based on policy changes, benefit updates, and changes to intranet web pages (see paragraph 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such software package into the system of Valentino. One of ordinary skill in the art would have been motivated to incorporate such a software package for the purpose of keep employees updated without requiring extensive monitoring of changes by the employees (see paragraph 11 of Secrist).

48. In addition, neither Valentino nor Secrist explicitly teach storing information regarding a request to be notified regarding the posting of an offering or an offer to sell a benefit or benefit package, detecting such a posting, and generating and transmitting a message upon the detection of the posting. However, Fox teaches a method of requesting to be notified regarding the posting of information (see column 5, lines 58-63); detecting the posting of information (see column 6, lines 7-17); and generating and transmitting a message upon the detection of the posting (see column 6, lines 15-36). It would have been obvious to incorporate such functionality of automatically generating messages to inform users of new information upon detection of posting of new information. One of ordinary skill in the art would have been motivated to incorporate such functionality for the purpose of automatically communicating pertinent information to users rather than requiring constant checking for updates (see column 1, lines 44-58).

49. As per claim 763, Valentino teaches the method of claim 762 as described above. Valentino further teaches the message is transmitted to the communication device in real-time (see column 2, lines 34-39).

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50. As per claim 764 Valentino teaches the method of claim 762 as described above.

Valentino further teaches the communication device is at least one of the recited devices (see column 4, lines 46-60).

51. As per claim 765, Valentino teaches the method of claim 762 as described above.

Valentino further teaches the communication device is a TV or an interactive TV (see column 4, lines 46-60).

52. As per claim 768, Valentino teaches the method of claim 762 as described above.

Valentino further teaches the message is transmitted to the communication device on or over an intranet (see column 3, line 64 – column 4, line 4, the Examiner interprets the company-wide network of Valentino to be a form of intranet).

53. As per claim 769, Valentino teaches the method of claim 762 as described above.

Valentino further teaches the employee benefits information is automatically updated in real-time (see column 2, lines 34-39).

54. As per claim 770, Valentino teaches the method of claim 762 as described above.

Valentino further teaches processing information regarding at least one of the listed items (see column 2, lines 1-20).

55. As per claim 771, Valentino teaches the method of claim 762 as described above.

Valentino further teaches processing information regarding at least one of the listed items (see column 2, lines 1-20).

56. As per claim 772, Valentino teaches the method of claim 762 as described above.

Valentino further teaches the message is contained in at least an electronic transmission (see column 3, lines 31-42).

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57. As per claim 773, Valentino teaches the method of claim 762 as described above. Valentino further teaches the message contains a link to a computer associated with the processing device (see column 3, lines 31-34).

58. As per claim 774, Valentino teaches the method of claim 762 as described above. Valentino further teaches processing employee benefit information, wherein the employee benefits information comprises information regarding an employee benefit associated with an employee, wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current employment relationship wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer (see column 2, lines 28-32, the Examiner interprets the recited "previous relationship" to be a previously established benefit arrangement between employee and employer), and further wherein the employee benefit information comprises information regarding an individual benefits account, wherein the individual benefits account is utilized by the individual to retain a benefit with a benefit provider independently of an employment relationship (see column 7, lines 8-9).

59. As per claim 775, Valentino teaches the method of claim 762 as described above. Valentino further teaches storing information regarding at least one of a benefit, benefit package, and a benefit pricing (see column 5, lines 16-22) and information regarding a requirement or a need for a benefit associated with an employer or employee (see column 2, lines 22-27); processing the information regarding at least one of a benefit, benefit package, and a benefit pricing with information regarding a requirement or a need for a benefit (see column 2, lines 22-27); identifying a benefit provider for providing at least one of a benefit and benefit information for the requirement for a benefit or for the need for a benefit (see column 2, lines 28-

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32); generating and transmitting a second message containing information regarding the benefit provider (see column 2, lines 28-32).

60. As per claim 776, Valentino teaches a computer implemented method comprising: storing employee benefit information in a database or memory device (see column 3, lines 57-61); detecting a posting of at least one of a need, a request, and a requirement, to buy or obtain a benefit or a benefit package, wherein the posting of at least one of a need, a request, and a requirement, to buy or to obtain a benefit or a benefit pack is automatically detected by a processing device (see column 5, lines 49-52); generating a message containing information regarding the posting of at least one of a need, a request, and a requirement, to buy or obtain a benefit or a benefit package, wherein the message is automatically generated by the processing device upon the detection of the posting of at least one of a need, a request, and a requirement, to buy or to obtain a benefit or a benefit package (see column 5, lines 53-59); and transmitting the message to a communication device associated with a benefit provider (see column 5, lines 53-59).

61. Valentino does not explicitly teach the detected offering or posting is of a benefit or benefit package not available to an employee or a benefit beneficiary in or pursuant to an employment relationship prior to the at least one of an offering of a benefit and a posting of an offer to sell a benefit or a benefit package. However, Secrist teaches a software application that monitors events in a business environment and automatically broadcasts messages based on changes in the business environment (see paragraphs 6-8). Furthermore, Secrist teaches that the software application can be utilized to broadcast messages based on policy changes, benefit updates, and changes to intranet web pages (see paragraph 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such software package into the system of Valentino to enable employees to broadcast notifications of required

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or requested benefit packages. One of ordinary skill in the art would have been motivated to incorporate such a software package for the purpose of keep employees updated without requiring extensive personal monitoring of changes (see paragraph 11 of Secrist).

62. In addition, neither Valentino nor Secrist explicitly teach storing information regarding a request to be notified regarding the posting of an offering or an offer to sell a benefit or benefit package, detecting such a posting, and generating and transmitting a message upon the detection of the posting. However, Fox teaches a method of requesting to be notified regarding the posting of information (see column 5, lines 58-63); detecting the posting of information (see column 6, lines 7-17); and generating and transmitting a message upon the detection of the posting (see column 6, lines 15-36). It would have been obvious to incorporate such functionality of automatically generating messages to inform users of new information upon detection of posting of new information. One of ordinary skill in the art would have been motivated to incorporate such functionality for the purpose of automatically communicating pertinent information to users rather than requiring constant checking for updates (see column 1, lines 44-58).

63. Claims 777 and 768-781 contain substantially similar additional limitations to those already recited in claims 763 and 768-770 and, as such, are rejected for similar reasons as given above.

64. Claims 555, 585, 598, 678, 694, 705, 766, and 795 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino, U.S. Patent No. 4,648,037 in view of Foster, Portability of pension benefits among jobs (hereinafter Foster, paragraphs numbered by Examiner) and further in view of Official Notice.

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65. As per claim 678, Valentino teaches the method of claim 661 as described above.

Valentino does not explicitly teach the communication device is a wireless device. However, the Examiner takes official notice that it was well known in the electronic arts to use wireless means to connect remote and central computers. The motivation was to provide network access to the service through handheld devices (i.e. PDA). It would have been obvious to one of ordinary skill in the art to include wherein the communication device is a wireless device within Valentino for the motivation stated above.

66. As per claim 694, Valentino teaches the method of claim 661 as described above.

Valentino does not explicitly teach processing information for pooling employees from different employers to obtain employee benefits for the employees of the different employers. However, the Examiner takes official notice that it was well known in the negotiations arts for unions to negotiate employment and benefits contracts for their members for an industry (i.e. multiple employers). The motivation would have been to standardize wages and benefits for the industry as a whole thereby ensuring standard wages and benefits for an industry and eliminating wage and benefits disparities between employers (i.e. standardizing employment costs). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations within Valentino for the motivation stated above.

67. As per claim 705, Valentino teaches the method of claim 661 as described above.

Valentino does not explicitly teach the utilization of a cable television network. However, the Examiner takes official notice that it was well known in the electronic communication arts, at the time of the invention, to utilize cable television networks for electronic communication (i.e. standard cable modem Internet access). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a cable network within the system of

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Valentino. One of ordinary skill in the art would have been motivated to utilize such a network for the purpose of providing expanded access to network services.

68. Claims 555, 585, and 598 recite substantially similar additional limitations as claims 678, 694, and 705 and, as such, are rejected for similar reasons as given above.

69. As per claim 766, Valentino teaches the method of claim 762 as described above.

Valentino does not explicitly teach the communication device is a wireless device. However, the Examiner takes official notice that it was well known in the electronic arts to use wireless means to connect remote and central computers. The motivation was to provide network access to the service through handheld devices (i.e. PDA). It would have been obvious to one of ordinary skill in the art to include wherein the communication device is a wireless device within Valentino for the motivation stated above.

70. As per claim 795, Valentino teaches the method of claim 661 as described above.

Valentino does not explicitly teach processing each of these employee benefits as claimed.

However, the Examiner takes Official Notice that these types of benefits are old and well known in the art of employee benefits administration. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such employee benefits into the system of Valentino. One of ordinary skill in the art would have been motivated to incorporate such benefits for the purpose of providing employees with greater flexibility in selecting various employee benefits.

71. Claims 548, 557, 600, 666, 680, 767, and 778 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino, U.S. Patent No. 4,648,037 in view of Foster, Portability of pension benefits among jobs (hereinafter Foster, paragraphs numbered by Examiner) and

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further in view of Asinof, Lynn, "Click & Shift: Workers Control Their Benefits Online"(hereinafter Asinof).

72. As per claim 666, Valentino teaches the method of claim 662 as described above.

Valentino does not explicitly teach the claimed processing of a request for a status of the request or claim for an employee benefit, generating, and transmitting the third message.

However, Asinof teaches such a feature as claimed (see last two paragraphs of page 1 and the first paragraph of page 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Valentino. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of allowing users to get benefits information at any time (i.e. employees will get information on their own timetable)(page 2, paragraphs 3 and 4) and reduce the cost of administering benefit programs to employers (page 2, paragraph 12).

73. As per claim 680, Valentino teaches the method of claim 661 as described above.

Valentino does not explicitly teach the utilization of the Internet or WWW as claimed. However, Asinof discloses wherein at least one of the computer-implemented method is utilized on or over at least one of the Internet and the World Wide Web, the at least one of a request for an employee benefit and a claim for an employee benefit is transmitted on or over at least one of the Internet and the World Wide Web, and the message is transmitted to the communication device on or over at least one of the Internet and the World Wide Web (page 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Valentino for the motivation stated above.

74. Claims 548, 557, and 600 recite substantially similar additional limitations as claims 666 and 680 and, as such, are rejected for similar reasons as given above.

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75. As per claim 767, Valentino teaches the method of claim 762 as described above.

Valentino does not explicitly teach the utilization of the Internet or WWW as claimed. However, Asinof discloses wherein at least one of the computer-implemented method is utilized on or over at least one of the Internet and the World Wide Web, the at least one of a request for an employee benefit and a claim for an employee benefit is transmitted on or over at least one of the Internet and the World Wide Web, and the message is transmitted to the communication device on or over at least one of the Internet and the World Wide Web (page 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Valentino for the motivation stated above.

76. Claim 778 recites substantially similar additional limitations claim 767 and, as such, is rejected for similar reasons as given above.

77. Claim 686 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino, U.S. Patent No. 4,648,037 in view of Foster, Portability of pension benefits among jobs (hereinafter Foster, paragraphs numbered by Examiner) and further in view of Greengard, Samuel, "Building a self service culture that works" (hereinafter Greengard).

78. As per claim 686, Valentino teaches the method of claim 661 as described above.

Valentino does not explicitly teach processing information regarding at least one of a registration for a class or course, a request for a tuition reimbursement. However, Greengard discloses processing information regarding at least one of a registration for a class or course, a request for a tuition reimbursement (i.e. enroll in training) (page 5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include processing information regarding at least one of a registration for a class or course, a request for a tuition reimbursement as disclosed by Greengard within Valentino. One of ordinary skill in the art

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would have been motivated to incorporate such a feature for the purpose further eliminating the need for involvement of a benefits administrator in handling employee benefit requests (see column 2, lines 34-39).

79. Claims 544, 546-547, 549-551, 553-554, 556, 558-560, 563-572, 582-584, 586-591, 594-597, 599, 782-794 and 796-808 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino, U.S. Patent No. 4,648,037 in view of Green, U.S. Patent No. 6,192,346 and further in view of Vizard, N.Y. saves big with client/server (hereinafter Vizard, paragraphs numbered by Examiner).

80. As per claim 544, Valentino teaches a computer-implemented method comprising: receiving information regarding a selection of an employee benefit, wherein an employee or a benefit beneficiary is previously enrolled in the employee benefit or an employee or a benefit beneficiary is provided with the employee benefit without enrolling (see column 7, lines 22-29); processing the information regarding a selection of the employee benefit (see column 7, lines 29-34); providing information or a link to information for making a request for an employee benefit or a claim for an employee benefit pursuant to or under the employee benefit (see column 7, lines 43-58); receiving a request for an employee benefit or a claim for an employee benefit, wherein the request for an employee benefit or the claim for an employee benefit is made pursuant to or under the employee benefit (see column 8, lines 36-46); processing the request for an employee benefit or the claim for an employee benefit with a processing device using employee benefits information stored in a database or memory device (see column 8, lines 46-52); generating a message in response to the request for an employee benefit or the claim for an employee benefit, wherein the message contains information regarding a providing of the employee benefit requested or claimed in the request for an employee benefit or the claim for an employee benefit (see column 8, lines 52-

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55); and transmitting the message to a communication device associated with at least the employee (see column 8, lines 52-55).

81. Valentino does not explicitly teach processing a request for at least one of vacation time information, personal time information, and sick time information; generating a message containing information regarding an amount of at least one of vacation time, personal time, and sick time, in response to a request for an employee benefit or claim for an employee benefit. However, Green teaches a system for managing a vacation and holiday scheduling system that includes generating a message containing information regarding an amount of at least one of vacation time, personal time, and sick time, in response to a request for an employee benefit or claim for an employee benefit (see column 2, line 67 – column 3, line 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a vacation time management feature into the system of Valentino. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of enhancing staff scheduling such that all needs of a business are efficiently met (see column 1, lines 42-46).

82. In addition, Valentino does not explicitly teach but Vizard teaches processing a request for an employee benefit (see paragraph 2); and determining with the processing device whether the employee benefit requested in the request for an employee benefit or the claim for an employee benefit is to be provided (see paragraph 12).

83. Claims 546-547, 549-551, 553-554, 556, 558-560, 563-572, 582-584, 586-591, 594-597, and 599 contain substantially similar additional limitations to claims 662-665, 667-677, 679, 681-693, 695-704, and 706-708 and, as such, are rejected for similar reasons as given above.

84. Claims 782-794 recite substantially similar limitations to those already addressed in claim 544 with the exception that they are directed to processing a second request for an employee benefit, wherein the employee benefit comprises: health insurance benefit, disability insurance

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benefit, life insurance benefit, pension benefit, employee stock benefit, stock option benefit, educational assistance benefit, tuition reimbursement benefit, credit union benefit, profit sharing benefit, employee discount program benefit, buying service benefit, and retirement benefit.

Valentino does not explicitly teach processing each of these employee benefits as claimed.

However, the Examiner takes Official Notice that these types of benefits are old and well known in the art of employee benefits administration. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such employee benefits into the system of Valentino. One of ordinary skill in the art would have been motivated to incorporate such benefits for the purpose of providing employees with greater flexibility in selecting various employee benefits.

85. Claims 796-808 recite substantially similar limitations to those already addressed in claim 544 with the exception that they are directed to various types of data contained in the message.

Valentino does not explicitly teach that the messages contain such information. However, the Examiner takes Official Notice that these types of information are old and well known in the art of employee benefits administration. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such employee benefits into the system of Valentino. One of ordinary skill in the art would have been motivated to incorporate such benefits for the purpose of providing employees with greater flexibility in selecting various employee benefits.

Response to Arguments

86. In the remarks filed 11/27/06, Applicant argues in substance that the claims, in view of the newly filed amendments, distinguish over the applied prior art. In response, the Examiner respectfully submits that the claims have now been address by new grounds of rejection detailed above. It is further submitted that the claims, as amended, have now been fully

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addressed by the new grounds of rejection and, accordingly, the corresponding arguments are now moot.


Conclusion

87. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

88. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

89. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/5/07


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